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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,015	02/07/2001	Jun Suzuki	Q62980	6229

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 SUGHRUE, MION, ZINN, MACPEAK & SEAS
 2100 Pennsylvania Avenue, N.W.
 Washington, DC 20037-3202

EXAMINER

LETSCHER, GEORGE J

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/778,015	Applicant(s) SUZUKI ET AL.	
	Examiner George J. Letscher	Art Unit 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinozuka et al (US 6,404,728).

Claims 3-5 recite the following elements, inter alia, disclosed in Shinozuka et al '728: a lens device (1) having an objective lens (2) and drive coils (12, 13) fixed to the lens holder (3); a plurality of wire-form elastic members (6) made of metal which energize the drive coils. The lens holder is a resin with its two side ends of wire-form elastic metal members such that the wire form members are embedded within the lens holder and suspension base; see Figures 3, 6 or 8 where the wire members are embedded, i.e., to make an integral part of, and fixed via adhesive; see column 3, lines 50-59 & column 12, lines 10-26. This electrically connects the wires 6 to the drive coils 12,13 and the lens holder. Two ends of the lens holder are exposed so that they are connection terminals to the drive coils. The lens and drive coils are fixed on the lens holder. See Figures 2-3 & 6-8 of Shinozuka et al '728.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Tanaka (US 5,068,844) view of Shinozuka et al '728.

The aforementioned claims recite the following features, inter alia, disclosed in Tanaka: a lens device (1) having an objective lens (28) and drive coils (29-31) fixed to the lens holder (25); a plurality of wire-form elastic members (14-15) made of metal which energize the drive coils. The lens holder has its two side ends connected with wire-form elastic metal members such that the wire form members are buried (claim 1), i.e., covered from view, as well as embedded (claim 3) within the lens holder and suspension base (via recesses (18a-d)) where they are fixed via adhesive; see Figures 1-2 of Tanaka; see column 3, lines 30-49 & column 12, lines 10-26. This

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electrically connects the wires (14-15, 21-22) to the drive coils and lens holder. Two ends of the lens holder are exposed so that they are connection terminals to the drive coils. The lens and drive coils are fixed on the lens holder.

Regarding claims 1 and 3, Tanaka does not expressly show the lens holder being a resin. Shinozuka et al '728 shows its lens device having an integral resin lens holder and wire holder; see column 8, lines 50-68. The description of Shinozuka et al '728 is in paragraph 3, *supra*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have furnished the optical disc lens drive device having wire-form elastic members integrally connected, buried, embedded, with lens and wire, i.e., connective holders, as shown by Tanaka with the lens holder being made of a resin as taught by Shinozuka et al '728. The rationale is as follows: one of ordinary skill in the art would have been motivated to have furnished the optical disc lens drive device having wire-form elastic members integrally connected, buried, embedded with fixing arms as shown by Tanaka as taught by Shinozuka et al '728 since one of ordinary skill in the art recognized that the wires were attached in such a manner that the positional relationships which they have immediately after they are molded are maintained; see column 3, lines 44-49 of Shinozuka et al '728.

Response to Arguments

6. Applicant's arguments filed 5/9/05 have been fully considered but they are not persuasive.

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On page 3, second paragraph of the remarks, Applicant asserts that Shinozuka does not teach a lens holder and suspension base which is *insert molded out of a resin on two end sides of wire-form elastic members* such that portions of the wire form elastic members are *embedded within* the lens holder and the suspension base, as required by claim 3. Once again, Applicant's arguments with respect to claims 3 and 5 have been considered by the Examiner but are not deemed persuasive as Tanaka clearly illustrates embedded wires in the lens holder and wire holder portions of the lens device. The "molding" term in the claims refers to a method step and has only been accorded weight as to its resin material structure. Applicant continues by stating that there is no "embedding within" of wire form elastic members within a lens holder and a suspension base. The Examiner respectfully disagrees as the wire form members of Shinozuka are embedded within the lens holder and suspension base in every sense of the phrase "embedding within." The crux of Examiner's response is that "insert molding" needs to be included with any argument in an attempt to distinguish the aforementioned claims over Shinozuka, thereby attempting to have a method step distinguish over a reference in a product claim.

Pages 4-6 deal with the embedded argument and the insert molding method step except that Tanaka is now addressed as being deficient for the "embedded within" and "insert molding" phrases. The Examiner's response above addresses these arguments likewise for Tanaka.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

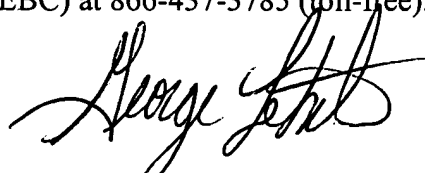
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George J. Letscher whose telephone number is 571-272-7591. The examiner can normally be reached on a Conventional work schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-437-3785 (toll-free).

A handwritten signature in black ink, appearing to read "George J. Letscher", with a stylized flourish at the end.

George J. Letscher
Primary Examiner
Art Unit 2653

GJL
8/16/05